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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,885	08/17/2001	Bruno Tisserand	IPG-PT065	5990
3624 7590 07/29/2009 VOLPE AND KOENIG, P.C. UNITED PLAZA, SUITE 1600 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103			EXAMINER DIVECHA, KAMAL B	
			ART UNIT 2451	PAPER NUMBER
			MAIL DATE 07/29/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/913,885

**Applicant(s)**

TISSERAND ET AL.

**Examiner**

KAMAL B. DIVECHA

**Art Unit**

2451

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

This Action is in response to communications filed 5/13/09.

Claims 1-7 and 10-16 are pending in this application.

Claims 8-9 were previously withdrawn.

**Response to Arguments**

Applicant's arguments filed in the submission above have been fully considered but they are not persuasive.

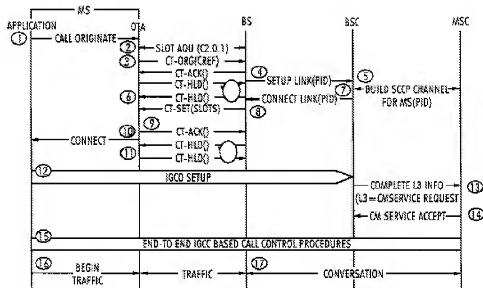
In the response filed, applicant argues in substance that:

- a. As amended, independent claims 1 and 10 recite, inter alia, placing a user message in a spare field of a signaling message for setting up the call channel, said signaling message including a parameter to indicate the presence of a said spare field, the user message originating at a mobile terminal. Lindsay and Ranta, whether taken alone or in combination, fail to teach or suggest at least these features (remarks, pg. 7).

In response to argument [a], Examiner respectfully disagrees.

Initially, Lindsay discloses activating a request to set up a call channel, performing a signaling stage including sending the signaling message and terminating the set up of the call channel at any time, as evidenced by the following figure.

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**Fig. 9**

MOBILE CALL ORIGINATION

In other words, the application at the mobile station originates the call set-up procedure by initiating the call originate request.

The "call originate" request (col. 20 L41 to col. 21 L12) comprises:

TABLE 10-4

Call Originate (CT-ORG)	
Information Element	Length in Bits
Message Type	8
Service Request	32
Key Sequence Number	8
Class	16
CRC	8
Reserved	96

The user station 102 sends a Call Originate (CT-ORG) control traffic message to the base station 104 to request the placement of an outgoing call.

The Service Request information element of the CT-ORG message indicates such things as data versus voice service, use of CRC and ARQ, symmetry or asymmetry of the channel, whether service resources are being requested, and frame rate, for example. The Key Sequence Number information element is used to generate a communication key in both the base station 104 and the user station 102 without having to explicitly pass the key over the air. The Class information element specifies some of the operational parameters of the particular type of user station 102. The Class information element can be broken down into sub-fields of Class Type and Class Information. The Class Type

In other words, the call request message includes various user messages such as service request information comprising data versus voice service, CRC, ARQ, service resources requested, frame rate, etc.

However, Lindsay does not disclose placing this user information in a spare field of a signaling message.

Ranta explicitly discovered and/or invented the usage of spare fields in the signaling messages for transmitting the information therein as evidenced by the following figure.

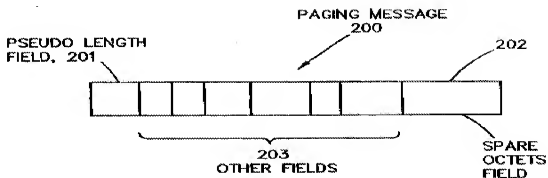


FIG. 2

Ranta further discloses the process of transmitting the information on this spare octet field, e.g. col. 2 L41-58.

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta in order to send the user information/message originating at a mobile terminal in the spare field of the paging message, i.e. signaling message.

One of ordinary skilled in the art would have been motivated for the reasons set forth in the rejection.

In the remarks, e.g. pg. 7, applicant admits that "Ranta discloses that the base station can transmit other information in parts of a paging channel". However, argues that "such paging channel information or other information that is communicated on a broadcast channel cannot properly be equated with a user message that originates at a terminal rather than a base station".

In response to applicant analysis, it should be noted that if a base station can transmit the other information in a spare field of a signaling message, than, there is no reason why cant a mobile station transmit the user message in the spare field of the signaling message. See MPEP 2144.04 VI (A). [A. Reversal of Parts: In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955)

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(Prior art disclosed a clock fixed to the stationary steering wheel column of an automobile while the gear for winding the clock moves with steering wheel; mere reversal of such movement, so the clock moves with wheel, was held to be an obvious expedient.)).

For the at least these reasons, the combination of Lindsay and Ranta discloses the functionality as set forth above. The rejection is maintained, and all prior responses are herein incorporated by reference.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-3, 6-7, 10-12 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindsay et al. (hereinafter Lindsay, US 6,301,242 B1) in view of Ranta (U. S. Patent No. 6,775,259 B1).

As per claim 1, Lindsay discloses a method of sending a signaling messages through a transmission network (fig. 1-2), comprising:

- activating a request to set up a call channel, wherein the request includes a user message originated at a mobile terminal (col. 18 L30-67, col. 20 L41 to col. 21 L12, col. 25 L62 to col. 26 L30, col. 24 L1-49, fig. 9 item #1);



- performing a signaling stage comprising sending said signaling message (col. 18 L30-67, col. 20 L41 to col. 21 L12, col. 25 L62 to col. 26 L30, col. 24 L1-49, fig. 9 item #1); and
- terminating the setting up of the call channel once the signaling message has been communicated without establishing the call, wherein the terminating step can be triggered/initiated at anytime (col. 24 L30-50, col. 27 L36 to col. 28 L26, col. 30 L66 to col. 31 L24; terminating the call during and/or prior of the establishment of the call channel).

However, Lindsay does not disclose the process of placing a user message (i.e. information) in a spare field of a signaling message for setting up the call channel, said signaling message including a parameter to indicate the presence of said spare field, and the process wherein the termination step is being triggered/initiated by the communication of the user message.

Ranta explicitly discloses placing information in a spare field of a signaling message for setting up the channel (note according to applicant specification, page 4, lines 15-24: the invention utilizes GSM standard 04.18) the signaling message includes an identifier (a parameter) to indicate the presence of said spare field and communicating the user message (col. 2 L41-58, col. 3 L63 to col. 4 L67, col. 5 L49-67, fig. 2).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta in order to place information and/or user message in a spare field of signaling message and terminate the set-up of the call channel once the user message has been communicated.

One of ordinary skilled in the art would have been motivated because it would have allowed the system to transmit information in an unoccupied part(s) of the signaling message (Ranta, col. 2 L13-25).

As per claim 2, Lindsay discloses the process wherein the user message is stored in a dedicated memory of the receiver of the user message (col. 9 L56 to col. 10 L10; Ranta: col. 6 L3-28).

As per claim 3, Lindsay discloses the process wherein a user is authorized to access the dedicated memory by means of specific commands (col. 9 L56 to col. 10 L10; Ranta: col. 6 L3-28; obviously it requires the commands to access the memory).

As per claim 6, Lindsay does not disclose the process wherein the size of the user message is limited to 35 eight-bit bytes at maximum (i.e. the user message is less than 35 bytes and/or in the range of 0-35 bytes).

Ranta discloses the process wherein the spare field (i.e. the user message that can be inserted into the spare field) is limited to 17 bytes (col. 3 L64 to col. 4 L10; i.e. 17 bytes is in the range of 0-35 bytes).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta in order to limit the size to 35 bytes at maximum.

One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 1.

As per claim 7, Lindsay discloses the process wherein the user message is communicated in an enciphered form (i.e. encrypted, col. 20 L1-40).

As per claim 10, Lindsay discloses a method of sending a signaling messages through a transmission network (fig. 1-2), comprising:

- activating a request to set up a call channel, wherein the request includes user message originated at a mobile terminal (col. 18 L30-67, col. 20 L41 to col. 21 L12, col. 25 L62 to col. 26 L30, col. 24 L1-49, fig. 9 item #1);
- performing a signaling stage comprising sending said signaling message (col. 18 L30-67, col. 20 L41 to col. 21 L12, col. 25 L62 to col. 26 L30, col. 24 L1-49, fig. 9 item #1);
- receiving a reply, i.e. ack, once the signaling message has been received (col. 27 L37-52); and
- terminating the setting up of the call channel once the signaling message has been communicated without establishing the call, wherein the terminating step can be triggered/initiated at anytime (col. 24 L30-50, col. 27 L36 to col. 28 L26, col. 30 L66 to col. 31 L24: terminating the call during and/or prior of the establishment of the call channel).

However, Lindsay does not disclose the process of placing a user message (i.e. information) in a spare field of a signaling message for setting up the call channel, said signaling message including a parameter to indicate the presence of said spare field, and the process wherein the termination step is being triggered/initiated by the receipt of the reply to the user message.

Ranta explicitly discloses placing information in a spare field of a signaling message for setting up the channel (note according to applicant specification, page 4, lines 15-24: the invention utilizes GSM standard 04.18) the signaling message includes an identifier (a parameter) to indicate the presence of said spare field and communicating the user message (col. 2 L41-58, col. 3 L63 to col. 4 L67, col. 5 L49-67, fig. 2).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta in order to place information and/or user message in a spare field of signaling message and terminate the set-up of the call channel once the reply to the user message has been received.

One of ordinary skilled in the art would have been motivated because it would have allowed the system to transmit information in an unoccupied part(s) of the signaling message (Ranta, col. 2 L13-25).

As per claim 11, Lindsay discloses the process wherein the reply to the user message is stored in a dedicated memory of the receiver of the user message (col. 9 L56 to col. 10 L10; Ranta: col. 6 L3-28).

As per claims 12 and 15-16, they do not teach or further define over the limitations in claims 1-3, 6-7 and 10-11. Therefore claims 12 and 15-16 are rejected for the same reasons as set forth in claims 1-3, 6-7 and 10-11.

2. Claims 4-5 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindsay et al. (hereinafter Lindsay, US 6,301,242 B1) in view of Ranta (U. S. Patent No. 6,775,259 B1), and further in view of Miller, II (hereinafter Miller, US 5,600,707).

As per claim 4, Lindsay discloses the process wherein the dedicated memory is in a mobile telephone and the transmission network is a mobile telephone network (fig. 2, col. 5 L50 to col. 6 L35, fig. 2A, col. 9 L56 to col. 10 L43: mobile telephone network).

However, Lindsay does not disclose the process wherein the mobile telephone is used as modem.

Miller explicitly discloses the process and apparatus, i.e. mobile device that can be used as a modem (col. 1 L30-55, col. 2 L26-61, fig. 1).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Miller in order to use mobile telephone as a modem.

One of ordinary skilled in the art would have been motivated because it would have enabled communications (Miller, col. 1 L31-65).

As per claim 5, Lindsay discloses the process wherein the dedicated memory is in a mobile telephone and using ISDN as the transmission network (col. 6 L60-67).

However, Lindsay does not disclose the process wherein the dedicated memory is in an ISDN-type modem.

Miller explicitly discloses an ISDN-type modem (fig. 1, col. 1 L31-65, col. 2 L62 to col. 3 L22).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Miller in order to include the dedicated memory in an ISDN-type modem.

One of ordinary skilled in the art would have been motivated because it would have allowed data communications (Miller, col. 1 L31-65).

As per claims 13-14, they do not teach or further define over the limitations in claims 4-5. Therefore, claims 13-14 are rejected for the same reasons as set forth in claims 4-5.

#### **Additional References**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Pohjakallio, US 5,502,721: Packet Data Transfer in a Cellular Radio System.
- b. Pettersson et al., US 6,304,595 B1: Mobile Telephone Modems.
- c. Hameleers et al., US 6,377,799 B1: Interworking function in an internet protocol based radio telecommunications network.
- d. Schiefer et al., US 5,884,175: Handover following in a mobile radio system.
- e. Clarke et al., US 5,550,914: Communications Signalling network apparatus.
- f. Rosenthal et al., U. S. Patent No. 5,737,701: Automatic Authentication System.
- g. Wallenius, U. S. Patent No. 6,466,786 B1: Call setup in Mobile Communications.

#### **Conclusion**

The teachings of the prior art shall not be restricted and/or limited to the citations by columns and line numbers, as specified in the rejection. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from

the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

In the case of amendments, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and support, for ascertaining the metes and bounds of the claimed invention.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kamal Divecha  
Art Unit 2451

/Hassan Phillips/  
Primary Examiner, Art Unit 2451